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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,993	12/28/2001	Susan McConnell	G&C 130.39-US-01	1833
22462	7590	01/24/2008		
GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045			EXAMINER KOHARSKI, CHRISTOPHER	
			ART UNIT 3763	PAPER NUMBER
			MAIL DATE 01/24/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/033,993

Applicant(s)

MCCONNELL ET AL.

Examiner

Christopher D. Koharski

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,9-25,30-37,43-59,64-68 and 107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 9-25, 30-37, 43-59, 64-68 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges the amendment filed 10/24/2007 in which claims 1, 24, 35, 58 and 107 were amended. Currently claims 1-2, 4, 9-25, 30-37, 43-59, 64-68 and 107 are pending for examination in this application.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) that were submitted on 10/31/2007 and 11/15/2007 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4, 9-16, 19-20, 24-25, 30-31, 35, 37, 43-48, 50, 56, 58, and 64-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Dragon (USPN5,236,143). Dragon discloses a tubing retractor apparatus.

Regarding claims 1-2, 4, 9-16, 19-20, 24-25, 30-31, 35, 37, 43-48, 50, 56, 58, and 64-65, Dragon discloses an apparatus (Figures 1 and 4) for dispensing medical infusion tubing (15) used to deliver a fluid and treat a physiological condition, the apparatus comprising: a housing (13), a replaceable spool cartridge (14) including medical tubing (15) having a fitting adapted (18) to connect to an infusion device (1, 3)

and tubing dimensions permitting the infusion of insulin in a fluid from the infusion device through the medical infusion tubing to an individual having the physiological condition, wherein the fitting (18) is not for piercing of an organ of the individual; a base (14a,c) for temporarily housing the medical infusion tubing, the base having an opening for receiving the medical infusion tubing; and a cover (other side of housing 13) attached to the base for substantially closing the opening; and an interface for mounting the housing (bottom surface of 13); and wherein the medical infusion tubing is dispensable with the housing to a fixable variable length from each side of the housing assembly (Figures 1-8, cols 1-2).

***Claim Rejections - 35 USC § 102***

Claims 1-2, 4, 9-11, 13-22, 24-25, 31-35, 37, 43-45, 47-49, 51-56, 58, and 65-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Pierce (USPN5,392,808). Pierce discloses a retractable tubing reel.

Regarding claims 1-2, 4, 9-11, 13-22, 24-25, 31-35, 37, 43-45, 47-49, 51-56, 58, and 65-68, Pierce discloses an apparatus (Figures 1 and 3) for dispensing medical infusion tubing (50) used to deliver a fluid and treat a physiological condition, the apparatus comprising: a housing (16), a replaceable spool cartridge (52) including medical tubing (50) having a fitting adapted (84) to connect to an infusion device (102) and tubing dimensions permitting the infusion of insulin in a fluid from the infusion device through the medical infusion tubing to an individual having the physiological condition, wherein the fitting (84) is not for piercing of an organ of the individual; a base (30) for temporarily housing the medical infusion tubing, the base having an opening for

receiving the medical infusion tubing; and a cover (14) attached to the base for substantially closing the opening; and an interface for mounting the housing (22); and wherein the medical infusion tubing is dispensable with the housing to a fixable variable length utilizing a lockable spring driven friction ratchet system (Figure 5, elements 66, 68, 70) (Figures 1-7, cols 1-2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 57 and 107 are rejected under 35 U.S.C 103(a) as being unpatentable over Dragon (or Pierce) in view of Synsteliën et al. (4,200,249). Dragon (or Pierce) meets the claim limitations as described above except for the attachment mechanism.

However, Synsteliën et al. teaches a storage device.

Regarding claims 57 and 107, Synstelién et al. teaches a two part storage system (48, 136) which comprises a spool (104) for winding and a belt clip (56) for attachment (Figures 1-10, cols 1-2).

At the time of the invention, it would have been obvious to add the clip attachment means to allow for securement of the assembly during use. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Synstelién et al. (cols 1-2).

#### ***Claim Rejections - 35 USC § 103***

Claim 36 is rejected under 35 U.S.C 103(a) as being unpatentable over Pierce. Pierce meets the claim limitations as described above except for the delivery of insulin.

Regarding claim 36, Pierce discloses the claimed invention except for delivery of insulin. It would have been an obvious matter of design choice to use the device of Pierce to deliver insulin, since applicant has not disclosed that the specific delivery of insulin solves any stated problem or is for any particular purpose.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-2, 4, 9-25, 30-37, 43-59, 64-68 and 107 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

***Suggested Allowable Subject Matter***

The following claim subject matter is suggested by the examiner and considered to distinguish patentably over the art of record in this application and is therefore presented to Applicant for consideration:

Examiner suggests the addition of limitations drawn to the manual winding mechanism as shown in Figures 1B or the tubing locking mechanism as shown in Figure 2.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 5:30am to 2:00pm EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date:

1/16/08

  
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